

**REMARKS**

Claims 1, 2 and 4-15 are pending and under consideration. Reconsideration is requested.

**Action Incomplete**

In response to the previous Office Action mailed February 24, 2005, Applicant filed an Amendment on May 24, 2005 (previous Amendment) and traversed the rejection of the claims arguing, in part, that Nakatsuyawa et al. (U.S.P. 5,752,021) does not teach the recited retrieving module but rather, Nakatsuyawa merely teaches reading out of a whole of a target document as a result of retrieving (step 24) based on the input retrieval formula.

On page 13 of the current Office Action, entitled Response to Arguments, the Examiner indicates that in response to Applicant's arguments that the cited art does not teach:

"retrieving ... document". The examiner disagrees and provides a more detailed explanation in the rejection (see above rejection).

However, in the current Office Action the Examiner merely repeats the same contentions from the previous Office Action, and does not respond to this argument. As set forth in MPEP § 706.07(d):

(i)f, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.

Accordingly Applicants submit that if the claims are not allowed, that at least the office action be reissued with a complete response and due date accordingly reset.

**Statement Incorrectly Attributed To Applicant**

The Action incorrectly states:

(a)pplicant argues . . . that Kuw(a)hara in view of Nakatsuyama does not teach the amended claimed limitations "correlation ... hierarchy". The applicant is arguing the claims as amended, for which (T)he Examiner disagrees and asserts a more detailed rejection to address the amended portions of the limitations.

(Action page 13).

Applicant submits that Examiner's statement is incorrect. Rather, it was the Examiner who conceded the same in the previous Action that indicated "regarding claim 3, Kuwahara in view of Nakatsuyama does not expressly teach... correlation between the elements."

Applicant respectfully requests correction of the same.

**Item 8.1: Rejection of Claims 1, 2, 4-10,12-15 under 35 U.S.C. §101**

In item 8-1 of the Action, the Examiner rejects claims 1, 2, 4-10, and 12-15 under 35 U.S.C. §101 contending that the claims are directed to non-statutory subject matter and not

"within the technological arts." (Action at page 3).

Applicant respectfully submits that the Examiners rejection lacks a foundation of law in that:

in the precedential decision of *Ex Parte Lundgren*, Appeal 2003--2088 (October 2005), the USPTO Board of Patent Appeals and Interferences has ruled "that there is currently no judicially recognized 'technological arts' test to determine patent eligible subject matter under § 101." The Board also specifically indicated that the non-precedential decision of *Ex Parte Bowman* was not a binding decision.

Accordingly Applicant submits that claims 1, 2, 4-10, 12-15 as currently written comply with under 35 U.S.C. §101 and request withdrawal of the rejection.

**Items 9-1 and 9-2: Rejection of claims 1-2, 4-10, and 12-15 under 35 U.S.C. §103(a)**

In item 9-2) the Examiner rejects independent claims 1, 2, 11, 12, and 14 (and respective dependent claims 6-10, 13, and 15) under 35 U.S.C. §103(a) as being unpatentable over Kuwahara (U.S.P. 6,202,072) in view of Nakatsuyama, and in item 9-1 rejects dependent claims 4 and 5 under 35 U.S.C. §103(a) as being unpatentable over Kuwahara. The rejections are traversed.

Applicant submits that features recited by each of the independent claims are not taught by even an *arguendo* modification of Kuwahara in a manner as the Examiner contends, and further there is no motivation to modify the art in a manner as the Examiner contends.

**I. Condition Of A Pattern Not Taught By Cited Art**

Independent claims 1-2, 11-12, and 14, each recite, using claim 1 as an example, "defining a correlation between elements as basic units configuring the document structure, and defining, for each of the elements, a condition of a pattern of a character string of plain text data as an extraction condition."

The Action concedes that Kuwahara does not teach a "condition of a pattern of a character string of plain text data" as a condition. (Action at page 7). However, the Examiner contends the feature is taught Nakatsuyama's retrieval formula, and it would have been obvious to one of ordinary skill to modify Kuwahara "to perform retrieval using semantic description."

Applicant submits that Nakatsuyama's teaching of a retrieval formula does not teach "pattern of a character string of plain text data" as the Examiner contends. Rather, Nakatsuyama merely teaches (see, for example, col. 3, starting at line 1):

(w)hen a user of the database...retrieves documents...he needs to...specify the name of a document component ("P" for a document of "Type C", for example) representative of a paragraph defined by the schema, and construct a retrieval formula using that name.

That is, a retrieval formula specifying a name of a document is not a "pattern of a character

string" of plain text data, as the Examiner incorrectly contends. Further, the Examiner contends that Kuwahara teaches:

"a structure document generating module ... the definition information" by teaching (i.e., generate a SGML document from a plain text document prepared by a user as part of the two directional conversion between plain text document and a SGML document having a specific form).

Applicant submits that this cited teaching of Kuwahara does not teach a generation of a structured document by adding to each region an identifier defined by the definition information, as recited by claim 1 for example.

## **II. Defining Correlation Between Elements As Basic Units Not Taught**

In rejecting claim 12, the Examiner contends that Kuwahara teaches, citing col. 5, lines 1-18 and lines 59-65:

reading definition information that defines a correlation between elements as basic units configuring a document structure of a structured document.  
(Action at page 10).

Applicant submits the Examiner is incorrect since Kuwahara merely teaches (see, for example, col. 5, lines 60-65):

by correlating a corresponding document structure in the document type definition with each of the fields for department and address respectively, it is possible to obtain data for correlation therebetween. Finally, by correlating an application form and the document type definition to data for correlation therebetween as one unit, a SGML conversion form is prepared.

That is, Kuwahara does not define a correlation between elements as basic units.

## **III. Repetitive Structure Not Taught By Cited Art**

Claim 4 recites a system wherein "said correlation between the elements shows a hierarchical structure in which said element in a higher-order hierarchy embraces an element in a lower-order hierarchy that has a repetitive structure."

The Action concedes that Kuwahara does not teach a "repetitive structure." (Action at page 4). In support of the rejection, the Examiner contends Kuwahara teaches in col. 2 lines 45-50:

that the prior art teaches a repetitive structure (i.e., conventional technology generates every time for the entire document type definition processing instead of only once).  
(Action at page 4).

However, claim 4 further recites that it is "an element in a lower-order hierarchy that has a repetitive structure" and then because of the element having such a repetitive structure that there is the "retrieving module repeatedly extracts regions."

The paragraph cited in Kuwahara (col. 2, lines 35-50) by the Examiner merely discusses:

(t)he apparatus for processing SGML document according to the present invention generates . . . by using the prototype document is converted to a SGML document. For this reason a conversion form corresponding to the specific form may be generated only once, and since it is not required to prepare samples such as components, markup documents, and document type definitions every time as in the case of the conventional technology.

(Emphasis Added).

That is, Kuwahara merely indicates that the "repeating" of the conventional technology that the invention improves on is a repeated preparation of samples such as components, markup documents and document type definitions every time a document is processed. Kuwahara does not teach "an element in a lower-order hierarchy that has a repetitive structure," and then, because of the element having such a repetitive structure that there is the "retrieving module repeatedly extracts regions."

Further, the Examiner mistakenly contends that it is possible to modify Kuwahara:

to include(s) generating conversion tables every time (instead of once) as suggest in the prior art of conventional technology, providing the benefit (of) correlating fields of the prototype document to tags of the document type definition when converting plain text to SGML.

Applicant submits there is no motivation to even *arguendo* modify Kuwahara to perform a repetitive process since Kuwahara clearly teaches that because:

a conversion form corresponding to the specific form may be generated only once . . . it is possible to improve the workability thereof.

#### **IV. Retrieving A Region Just After An Already-Extracted Region Not Taught By Cited Art**

Claim 5 recites a structural documentation system "wherein said correlation between the elements shows a hierarchical structure in which one element in a higher-order hierarchy embraces a plurality of sequenced elements in a lower-order hierarchy and said retrieving module extracts each region coincident with one of said extraction conditions of the elements in the lower-order hierarchy with reference to the extraction condition of the sequenced element in the lower-order hierarchy out of a region from a portion just after an already-extracted region coincident with another extraction condition of the element in lower-order hierarchy within the region extracted with reference to the extraction condition of the element in its higher order hierarchy."

The Examiner also supports the rejection of claim 5 by relying on "Kuwahara . . . in conjunction with the teachings of Nakatsuyama." Applicant respectfully points out that the Examiner's statement indicates his reliance on Nakatsuyama, in addition to Kuwahara, for the rejection of claim 5 under 35 U.S.C. §103(a). The rejection is traversed.

The Examiner contends that Kuwahara teaches a feature of claim 5 that "said retrieving

module extracts [ ] coincident with one higher order hierarchy" since:

in order to have a specific form, there must be some condition of specificity in order to perform the conversion which is found out from the document type definition.

(Action at page 5).

Applicant submits that the Examiner's contention is incorrect.

#### **IV. a) Examiner's Conclusory Statement Not Supported**

Further, the Examiner has provided no support that such even given such assumption, that further the assumption teaches "the elements in the lower-order hierarchy with reference to the extraction condition of the sequenced element in the lower-order hierarchy out of a region from a portion just after an already-extracted region," as recited by claim 5.

The Applicant respectfully traverses the Examiner's statement and demands the Examiner produce authority for the statement. As set forth in M.P.E.P. § 2144.03(e):

any facts so noticed should . . . serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

Further, it appears that the Examiner also bases the rejection, at least in part, on personal knowledge. The Examiner is required under 37 C.F.R. § 1.104(d)(2) to support such an assertion with an affidavit when called for by the Applicant. Thus, Applicant calls upon the Examiner to support such assertion with an affidavit.

#### **IV. b) No Motivation To Modify The Art**

While the Action concedes that Kuwahara does not teach "each region" as recited by claim 5 the Examiner contends that Kuwahara teaches that "prior art teaches a repetitive structure. . .and it would be obvious to modify Kuwahara to include(s) generating conversion tables every time."

Applicant also submits there is no motivation to even *arguendo* modify Kuwahara to perform a repetitive process, as the Examiner contends.

#### **Summary**

Since *prima facie* obviousness is not established, the rejection should be withdrawn and claims 1, 2 and 4-15 allowed.

#### **CONCLUSION**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is

requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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